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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,278	09/11/2003	William J. Carroll	000309-00049	5691

27557 7590 04/19/2007
BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

MANUEL, GEORGE C

ART UNIT	PAPER NUMBER
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3762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/659,278

Applicant(s)

CARROLL ET AL.

Examiner

George Manuel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 39, 40 and 43 rejected under 35 U.S.C. 102(e) as being clearly anticipated by McGraw et al (US 6,393,328).

2. Claims 39-42 and 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,083,712 ("Keegan, Jr.").

Keegan, Jr. teaches a device for producing transcutaneous electrical muscle therapy. Figure 1 illustrates that at least two electrodes are secured to a body segment (electrode 13 and 17 are illustrated as attached to a leg 11 of a patient. Figure 1 illustrates electrode 13 above the knee, or at the patient's thigh, and electrode 17 below the knee such that the electrodes are proximate the knee of the patient, which is necessarily a joint having a synovium). The device produces sequential programming of synthetic exterior muscle stimulation (see col. 1, lines 55-56), wherein such programmed stimulation is between antagonistic muscles in a proper time relation required for normal function of the muscles (see col. 1, line 70 - col. 2, line 2). Examiner considers such sequential programming "to mimic a sequencing of at least two muscle

groups proximate to the body segment” since such stimulation sequence includes a proper time relation required for normal function of the muscles. The electrical stimulation sequencing is believed to provide a movement pattern close to the movement pattern of a normal function muscle, and presents an opportunity for retraining and muscle re-education (see col. 5, line 67 - col. 6, line 3).

With respect to claims 41-42, Keegan, Jr. discloses that the electrical therapy stimulates the nerve and associated muscle (see col. 3, lines 10-12), and thus necessarily provides neuromuscular electrical stimulation.

3. Claims 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,165,750 (“Aleev et al.”).

Aleev et al. discloses a bioelectrically controlled electric stimulation in which the sequence of the electrical stimulation corresponds to the sequence of contractions of muscles in natural conditions (see col. 1, lines 30-45). Examiner considers such sequential programming “to mimic a sequencing of at least two muscle groups proximate to the body segment” since such stimulation sequence corresponds to the sequence of contractions of muscles in natural conditions. Such stimulation is believed to restore the strength of damaged muscles and also restores lost motor skills for enabling a person to perform compound motions of the extremities, torso, and head (see col. 1, lines 25-30 and 40-45). The electric stimulator utilizes an activity sensor (2) which includes two electrodes (3) attached to a first person’s skin proximate to muscles for obtaining the bioelectric activity of muscles of a person who sets a program of

movements (see col. 7, 30-40 and Figure 1; see also col. 11, lines 23-35). Such program of movements is used to stimulate the muscles of a second person under control via two electrodes 19 (see col. 8, lines 15-25 and Figure 1; see also col. 11, line 62 - col. 12, line 33).

With respect to claims 41-42, the electrical stimulation of Aleev et al. causes the muscles to be excited and contract, and thus necessarily provides neuromuscular electrical stimulation (see, as evidence, U.S. Patent No. 5,070,873 at col. 1, lines 23-30 which describes that muscle fibers contract in response to the electrical stimulation of neural motor units).

4. Claims 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,350,415 ("Cywinski").

Cywinski discloses a method for the electrostimulation of muscles, which electronically synthesizes the stimulus firing patterns to be similar to that of recorded, natural Motor Unit Action Potentials (or MUAPs), which are electrical discharges in individual groups of muscle cells which contract together, in order to provide functional and structural trophic changes in the muscle (see col. 3, lines 8 - 69). Such an electrical stimulation pattern is applied to a body segment via stimulating electrode means (3), which includes at least two electrodes as shown in Figures 3, 5, and 7. Examiner considers electrical stimulation "adapted to mimic a sequencing of at least two muscle groups proximate to the body segment" to encompass the electrical stimulation

disclosed in Cywinski which is adapted to emulate the natural MUAPs because such MUAPs are naturally-occurring electrical discharges of a muscle group.

With respect to claims 41-42, Cywinski discloses that the device is a neuromuscular stimulator (see col. 3, line 25-26).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,083,712 ("Keegan, Jr.").

Keegan, Jr. fails to explicitly disclose applying the electrical stimulation for approximately ten minutes to approximately four hours. Keegan, Jr. teaches that the time interval for stimulation is controlled by capacitor 69 (see col. 4, lines 50-57), which is programmed in accordance with normal muscle function. Further, Keegan, Jr. teaches that it is important to for the muscle to get enough stimulation to work the muscle without over stimulation which would cause discomfort and muscle fatigue (see col. 3, lines 69-73). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Keegan, Jr. such that the treatment time is between ten minutes to four hours in order to work the muscle without over stimulation which would cause discomfort and muscle fatigue. Examiner notes that

it has been held that discovering an optimum value of a result effective variable (such as, in this case, the time for electrical stimulation treatment) involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

7. Claims 39, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,324,317 ("Reiss") in view of U.S. Patent No. 3,083,712 ("Keegan, Jr.").

Reiss discloses a portable inferential stimulator for producing a low frequency therapeutic current at a selected point in order to reduce pain, reduce edema and inflammation, increase blood flow, and reduce muscle spasms (see Abstract). Reiss discloses that the inferential stimulator includes a mode control to permit changing the sequence of stimulation to find the most effective pain relief (see col. 1, line 62 - col. 2, line 16). Reiss fails to specifically disclose a mode of operation in which the electrical stimulation is applied having characteristics and sequencing which mimic normal electrical sequencing of surrounding muscles of the joint during normal functioning activity. Keegan, Jr. teaches a device for producing transcutaneous electrical muscle therapy which produces sequential programming of synthetic exterior muscle stimulation, wherein such programmed stimulation is between antagonistic muscles in a proper time relation required for normal function of the muscles (see col. 1, line 70 - col. 2, line 2). The electrical stimulation sequencing is believed to provide a movement pattern close to the movement pattern of a normal function muscle, and presents an opportunity for retraining and muscle re-education (see col. 5, line 67 - col. 6, line 3). It

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would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the sequence of stimulation of the inferential stimulator disclosed in Reiss such that the sequence of stimulation mimics normal electrical sequencing of surrounding muscles of the joint during normal functioning activity as taught by Keegan, Jr. in order to retrain and re-educate the muscle to take over normal function and control while simultaneously providing pain relief.

With respect to claim 43, Reiss discloses that the electrical stimulation includes a duration from 10 minutes to 4 hours per day (treatments of up to about 60 minutes are preferred; see col. 2, lines 20-26).

With respect to claim 44, Reiss discloses that the electrical stimulation is within a range of 5 mA to 150 mA (the preferable output amperage varies from about 0 to 50 milliamps; see col. 2, lines 18-26).

Response to Arguments

8. Applicant's arguments filed 11/9/06 have been fully considered but they are not persuasive.

9. With respect to *Hoffman*, *Reiss* and *Cywinski* not disclosing or suggesting mimicking the sequencing of at least two muscle groups sufficient to cause a visible and forceful contraction of those muscle groups, Fulkerson et al (US 4,738,250) teaches they may provide such mimicking since they are a type of transcutaneous electrical nerve stimulation and TENs devices are capable of producing a spiked waveform of

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electrical energy of sufficient magnitude and duration to cause muscle twitching and contractions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is 571-272-4952. The examiner can normally be reached on Monday through Friday, 8 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


George Manuel
Primary Examiner